

Appl. No. 10/516,672

Amdt. dated March 27, 2009

Reply to Office Action of 10/02/2008

### **REMARKS**

Reconsideration of the present application, as amended, is respectfully requested. As a result of the present amendment, claims 25-29, 31-32, 36-41, 43-46, and 51-54 are under prosecution. Claims 33-35 and 42 are newly cancelled, without prejudice.

### **AMENDMENTS TO THE CLAIMS**

Claims 25 (product by process) and 31 (process) are amended to more particularly set forth that which Applicants consider to be their invention, by specifying the composition of the catalyst employed in the recited process. Claim 31 is made independent. The catalyst composition is supported, e.g., from pages 7-9 of the specification. The surface area range of 150 to 350m<sup>2</sup>/g is supported by page 11, lines 19 to 23. The dependent claims are conformed accordingly, where appropriate. New claim 54 is based on previously pending claim 46.

No new matter is added.

### **THE CLAIMS ARE NOVEL AND NONOBVIOUS OVER HOEK, AND HOEK IN VIEW OF EILERS AND/OR BERTAUX**

At items 9-20 of the Office Action, the Examiner has rejected claims 25-29, 31-46, and 51-53 as allegedly "unpatentable under 35 U.S.C. 102(e) as anticipated by or, in the alternative, claims 25-50 are rejected under 35 U.S.C. 103(a) as allegedly obvious over Hoek (US 200410199040)." The Examiner further rejects claims 25-50 under yet another alternative theory, "under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoek (US 200410199040), as evidenced by Eilers (EP 668342 A1) and/or Bertaux (EP 776959 A2)."

Applicants respectfully disagree, as follows. Anticipation requires the presence in a single prior art disclosure of each and every element of a claimed invention. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994) or *see* the Manual of Patent Examining Procedure (MPEP) §2131.

In order to make out a *prima facie* rejection of the claims as allegedly obvious, the facts must show that the elements of the rejected claim(s) are present or suggested, e.g., by one or

more references. The claimed invention must be viewed as a whole. *See generally* MPEP §§ 2141 and 2142.

At items 10-13 of the Office Action, the Examiner has cited Hoek as allegedly anticipating claims 25, 27, 28 and 29, respectively, while at the same time conceding (at item 10 of the Office Action) that:

Hoek does not explicitly disclose wherein the FT paraffins have a carbon chain length distribution in the range from 20 to 105 at temperatures above 200°C or wherein the catalytic hydroisomerization occurs in the presence of a  $\beta$ -zeolite catalyst.

The Examiner further argues that Hoek discloses a material that is derived from an FT synthesis, as described by Eilers and Bertaux, and that a preferred catalyst is one such as described by Bertaux, which is based on a beta zeolite.

The claims must be considered as a whole, and given the requirements of claims 25 and 31, *et seq.*, it is respectfully urged that the pending claims are novel in view of Hoek, even when Hoek is further viewed in light of the descriptions provided by Eilers and/or Bertaux. The pending claims now clearly require that the catalyst comprises one or more transition group 8 metals, with the other enumerated structural and composition requirements, where the one or more transition group metals can comprise platinum, as specified by claims 25 and 31, taken with claims 43 and 54, respectively.

At items 14-20, the Examiner has cited Hoek against claims 31, 32, 41, 38-39, 40, 51, 42-44, 52, 45-46 and 53, respectively, contending that claim 31, and each respective dependent claim, is anticipated by, or in the alternative, obvious over Hoek and/or Hoek in view of Eilers and/or Bertaux. Applicants submit that claim 31, as pending, is both novel and nonobvious in view of the cited references, based on the clear lack of any teaching or suggestion of the claimed process.

For example, the Bertaux catalyst, that is stated by Hoek to be preferred, is described in Example 1 of Bertaux, at Col. 6, lines 31-34 as a, "fluorided NiW/alumina catalyst (5.0 %wt Ni, 23.1 %wt W, 4.6 %wt F, all based on total weight of carrier)." It is submitted that there is no teaching of record of a catalyst according to claims 25 or 31, comprising:

60 to 95 by mass of zeolite of the beta type, based on the combination of all components fired at 800°C, 5 to 39.8 by mass of gamma-aluminum oxide having a specific surface area of 150-350 m<sup>2</sup>/g, calculated as Al<sub>2</sub>O<sub>3</sub> and based on the combination of all components fired at 800°C, and one or more metals of transition group 8 of the periodic table, in an amount of 0.2 to 2.0 by mass, based on the combination of all components fired at 800°C, the one or more transition group 8 metals being attached to the gamma-aluminum oxide.

It is submitted that this is a completely different catalyst from that preferred by Hoek (citing Bertaux), and that this further negates a finding of both anticipation and obviousness. The mention by Hoek and/or Bertaux of a preferred catalyst as platinum or palladium (Hoek, paragraph 8, or Bertaux at Col. 4, lines 27-360), are also urged to be general statements, that fail to provide the specific catalytic composition required by claims 25 and 31, *et seq.* Further, it is urged that there is no teaching or suggestion found in any of the above cited three references, taken in any combination, that would have suggested to the ordinary artisan to construct the process, using the particular inventive catalyst composition, as required by claims 25 and 31, *et seq.* Applicants note that the above response is believed to fully respond to the rejections detailed by items 10-20 of the Office Action, which relate, *inter alia*, to claims 25 and 31 and the claims depending therefrom.

For all of these reasons, reconsideration and withdrawal of these grounds of rejection is respectfully requested.

#### **THE CLAIMS ARE NONOBVIOUS IN VIEW OF WITTENBRINK**

At items 24-35 of the Office Action, the Examiner has rejected claims 25-29, 31-46, and 51-53 as allegedly obvious under 35 U.S.C. 103(a) over Wittenbrink (WO01/74969 A2). The Examiner takes the position that

with respect to claim 25, Wittenbrink discloses a microcrystalline paraffin as solid product, prepared by catalytic hydroisomerization of FT paraffins having a carbon chain length distribution greater than 20 (see Wittenbrink, Abstract; and page 5, first paragraph). Wittenbrink does not explicitly disclose wherein the hydroisomerization occurs in the presence of a  $\beta$ -zeolite catalyst. However, Wittenbrink discloses wherein the hydroisomerization catalyst support may be zeolite (see Wittenbrink, page 8) ("The support for the metals can be any refractory oxide or zeolite or mixtures thereof.") (emphasis added).

Applicants respectfully disagree. The burden is on the Patent Office to initially provide facts supporting a *prima facie* rejection under 35 U.S.C. 103(a). As noted above, in order to make out a *prima facie* rejection, the facts must show that the elements of the rejected claim(s) are present or suggested, e.g., by one or more references. Here, it is submitted that the clear differences between the required elements of claims 25 and 31, *et seq.*, and that which is taught by Wittenbrink, negate the alleged rejection.

For example, as noted above, claims 25 and 31, and the claims depending therefrom, require that the process of the invention be conducted in a specific range of temperature and pressure, and with a particular catalyst. It is respectfully submitted that the Patent Office has not met its burden of showing all of the elements of claims 25 and 31, taken as a whole, by Wittenbrink. Further, there is no showing of record why the ordinary artisan would think to make the alleged modifications of Wittenbrink, given the specific process parameters and catalyst composition that is required by the pending claims.

Applicants note that the above response is believed to fully respond to the rejections detailed by items 24-35 of the Office Action, which relate to claims 25 and 31 and the claims depending therefrom.

For all of these reasons, reconsideration and withdrawal of these grounds of rejection is respectfully requested.

#### THE OBVIOUSNESS-TYPE DOUBLE-PATENTING REJECTION

At item 36 of the Office Action, the Examiner has *provisionally* rejected claims 25-27, 29, and 31-53 on the ground of nonstatutory obviousness-type double-patenting over claims 1-21 of copending Application No. 10/477,910.

Applicants respectfully disagree. To begin, given the recent claim amendments, cancelling product-by-process claims, during the ongoing prosecution of Ser. No. 10/477,910, it is submitted that the *provisional* rejection of instant claims 25-27 and 29 as alleged nonstatutory obviousness-type double-patenting, is now obviated. The Examiner is respectfully referred to enclosed Supplemental IDS, which provides, *inter alia*, a copy of the most recently pending claims in Ser. No. 10/477,910, as part of a recently filed Amendment and Response.

Further, as noted above, the presently pending claim 31, and those claims depending therefrom, require that the catalyst comprise:

60 to 95 by mass of zeolite of the beta type, based on the combination of all components fired at 800°C, 5 to 39.8 by mass of gamma-aluminum oxide having a specific surface area of 150-350 m<sup>2</sup>/g, calculated as Al<sub>2</sub>O<sub>3</sub> and based on the combination of all components fired at 800°C, and one or more metals of transition group 8 of the periodic table, in an amount of 0.2 to 2.0 by mass, based on the combination of all components fired at 800°C, the one or more transition group 8 metals being attached to the gamma-aluminum oxide.

It is respectfully submitted that nowhere in the pending claims of Ser. No. 10/477,910, and/or in any of the art of record, is there any teaching or suggestion to conduct the process of claims 25

and 31, *et seq.* with the recited catalyst.

For all of these reasons, reconsideration and withdrawal of these *provisional* grounds of rejection is respectfully requested.

### CONCLUSION

In the event there are further issues remaining in any respect the Examiner is respectfully requested to telephone attorney to reach agreement to expedite issuance of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Since the present claims set forth the present invention patentably and distinctly, and are not taught by the cited art either taken alone or in combination, this amendment is believed to place this case in condition for allowance and the Examiner is respectfully requested to reconsider the matter, enter this amendment, and to allow all of the claims in this case.

### FEES

This Response is being filed with a Petition for a Three Month Extension of Time, a Request for Continued Examination and fees required therefor. There should be no additional claim fee for the new claims added in view of the cancellation of claims previously paid for. No further fee is believed to be due. If, on the other hand, it is determined that further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

Respectfully submitted

by:

Laurence Manber

Registration No.: 35,597

LUCAS & MERCANTI, LLP  
475 Park Avenue South  
New York, New York 10016  
Phone: 212-661-8000  
Fax: 212-661-8002